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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,476	02/05/2004	Michael K. Brown	13210-140	4975

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EXAMINER
LAI, MICHAEL C

ART UNIT	PAPER NUMBER
2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/772,476	BROWN ET AL.
	Examiner	**Art Unit**	
	Michael C. Lai	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-46</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-46</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>05 February 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☒ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>17 feb 2005, 27 feb 2006</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1. This office action is responsive to communication filed on 02/05/2004. Claims 1-46 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 02/07/2003. It is noted, however, that applicant has not filed a certified copy of the PCT/CA03/00182 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-13, 15-35, and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasai et al. (US 7,216,072 B2, hereinafter Kasai), and in view of Ye et al. (US 2003/0105873 A1, hereinafter Ye).

Regarding claim 1, Kasai discloses a method of converting an initial message residing in a mobile computer device capable of wireless access to a computer network into a processed message, the method comprising:

presenting a menu option to a user of the device for converting the initial message into the processed message, wherein program instructions for

presenting the menu option originate in the mobile computer device [FIG. 3

and col. 5, lines 63-66];

after the user selects the menu option to convert, sending a representation

of the initial message to at least one server on the computer network for

converting the representation of the initial message into the processed

message [col. 6, lines 2-5, request message]; and

the mobile computer device receiving a representation of the processed

message from a particular one of the at least one server [col. 6, lines 2-5,

response message].

Kasai discloses all limitations of claim 1, except wirelessly communicating

with the computer network. However, Ye teaches techniques using a mobile

device to wirelessly interact with services in the computer network [FIG. 1A and

paragraphs 0015-0020]. It would have been obvious to a person with ordinary

skill in the art at the time the invention was made to incorporate Ye's teaching

into Kasai's method for the purpose of providing an wireless message converting

system.

Regarding claim 2, Kasai-Ye disclose the method of claim 1, wherein, in the

step of wirelessly sending, the at least one server includes a proxy and a

processing server, the representation of the original message being sent first to

the proxy and then to the processing server [Kasai, FIG. 1].

Regarding claim 3, Kasai-Ye disclose the method of claim 2, wherein the

proxy converts the representation of the message into a new format before

sending the reformatted representation of the message to the processing server [Kasai, col. 6, lines 6-9, the WWW server uses HTML implying the proxy converts the message into a new format before sending the message to the server].

Regarding claim 4, Kasai-Ye disclose the method of claim 3, wherein the new format is hypertext markup language (HTML) [Kasai, col. 6, lines 6-9].

Regarding claim 5, Kasai-Ye disclose the method of claim 1, wherein, in the step of receiving, the representation of the processed message is received by the mobile computer device via a proxy in the computer network [Kasai, FIG. 1].

Regarding claim 6, Kasai-Ye disclose the method of claim 5, wherein the proxy converts the processed message into a device-formatted representation of the processed message before sending to the mobile computer device [Kasai, col. 6, lines 6-9, the WWW server uses HTML implying the proxy converts the message into a device-formatted message before sending it to the mobile device].

Regarding claim 7, Kasai-Ye disclose the method of claim 1, wherein the menu option is a translation option, an encryption option, a spell check option or a thesaurus option [Kasai, FIG. 3 and col. 7, lines 17-21, translation option].

Regarding claim 8, Kasai-Ye disclose the method of claim 1, wherein the initial message is text displayed on the mobile computer device in a first language [Kasai, FIG. 3].

Regarding claim 9, Kasai-Ye disclose the method of claim 8, wherein the text forms part of an email [Kasai, FIG. 9 and col. 14, lines 19-34].

Regarding claim 10, Kasai-Ye disclose the method of claim 8, wherein the text is in a Web page [Kasai, FIG. 1, browser on the device and the WWW server uses HTML].

Regarding claim 11, Kasai-Ye disclose the method of claim 8, wherein the menu option is a translation option, such that when the translation option is selected, a pop-up is displayed prompting a user of the mobile computer device to choose at least one translation characteristic option [Kasai, FIG. 3 and col. 6-7, lines 59-26].

Regarding claim 12, Kasai-Ye disclose the method of claim 11, wherein the pop-up prompts the user to identify the first language [Kasai, FIG. 3 and col. 6-7, lines 59-26].

Regarding claim 13, Kasai-Ye disclose the method of claim 11, wherein the pop-up prompts the user to choose a second language into which the text is to be translated [Kasai, FIG. 3 and col. 7, lines 22-26].

Regarding claim 15, Kasai discloses a method for translating text displayed in a mobile computer device capable of wireless access to a computer network, the method comprising:

receiving the text in a first language [FIG. 3];

presenting a menu option to a user of the device for translating the text, wherein program instructions for presenting the menu option originate in the mobile computer device [FIG. 3 and col. 5, lines 63-66];

sending a representation of the text to at least one server on the computer

network to translate the representation of the text into a second language [col.

6, lines 2-5, request message]; and

receiving a second representation of the translated text [col. 6, lines 2-5,

response message].

Kasai discloses all limitations of claim 15, except wirelessly communicating

with the computer network. However, Ye teaches techniques using a mobile

device to wirelessly interact with services in the computer network [FIG. 1A and

paragraphs 0015-0020]. It would have been obvious to a person with ordinary

skill in the art at the time the invention was made to incorporate Ye's teaching

into Kasai's method for the purpose of providing a wireless message translating

system.

Regarding claim 16, Kasai-Ye disclose the method of claim 15, wherein, in

the step of receiving the text in a first language, the text is received in an email

[Kasai, FIG. 9 and col. 14, lines 19-34].

Regarding claim 17, Kasai-Ye disclose the method of claim 15, wherein, in

the step of receiving the text in a first language, the text is received in a Web

page [Kasai, FIG. 1, browser on the device and the WWW server uses HTML].

Regarding claim 18, Kasai-Ye disclose the method of claim 15, further

comprising, before the step of wirelessly sending, inputting a command into the

mobile computer device indicating a request to have the text translated [Kasai,

col. 24, lines 44-50].

Regarding claim 19, Kasai-Ye disclose the method of claim 15, further comprising, before the step of presenting, selecting a menu having a translation menu option [Kasai, FIG. 3 and col. 7, lines 17-21, translation option].

Regarding claim 20, Kasai-Ye disclose the method of claim 19 where, upon selecting the translation menu option, a pop-up is displayed prompting a user of the mobile computer device to choose at least one translation characteristic menu option [Kasai, FIG. 3 and col. 6-7, lines 59-26].

Regarding claim 21, Kasai-Ye disclose the method of claim 20, wherein the pop-up prompts the user to identify the first language [Kasai, FIG. 3 and col. 6-7, lines 59-26].

Regarding claim 22, Kasai-Ye disclose the method of claim 20, wherein the pop-up prompts the user to choose the second language [Kasai, FIG. 3 and col. 7, lines 22-26].

Claims 23-35 are of the same scope as claims 1-13. They are rejected for the same reason as for claims 1-13 respectively.

Claims 37-44 are of the same scope as claims 15-22. They are rejected for the same reason as for claims 15-22 respectively.

Claim 45 is of the same scope as claim 1. It is rejected for the same reason as for claim 1.

Regarding claim 46, Kasai-Ye disclose the computer-readable medium of claim 45, wherein the initial message is in a first language, and the processed

message is in a translated language [Kasai, col. 6, lines 2-5, request/response

messages].

5. Claims 14 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kasai-Ye as applied to claim 1.

Regarding claim 14, Kasai-Ye discloses the method of claim 1, but silent

about further comprising, before the step of presenting, automatically checking to

determine whether the initial message corresponds to text in a language that is

not native to a user of the mobile computer device. Official Notice is taken for

checking the initial message to see if the text is in a language that is not native to

the user, as this is essential for determining if a translation is needed. It would

have been obvious to a person with ordinary skill in the art at the time the

invention was made to do so for the purpose of avoiding unnecessary operation

by determining if a translation is needed before presenting the menu to the user,

thereby providing a more efficient translation system.

Claim 36 is of the same scope as claim 14. It is rejected for the same reason

as for claim 14.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Applicant is reminded that in amending in response to a

rejection of claims, the patentable novelty must be clearly shown in view of the

state of the art disclosed by the references cited and the objection made.

Applicant must show how the amendments avoid such references and

objections. See 37 CFR 1.111(c).

7. Hokao, US 6,907,256 B2, has taught a mobile terminal with an automatic

translation function.

8. Hayashi Hiroto, JP 2001 251429 A, has taught a mobile voice translation system.

9. Fish, WO 02/23389 A1, has taught systems and methods for translating
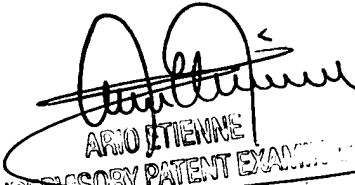
information.

Examiner's Note: Examiner has cited particular columns and line numbers in

the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and

are applied to specific limitations within the individual claim, other passages and

figures may apply as well. It is respectfully requested from the applicant in

preparing responses, to fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the context of the passage

as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully

requested to indicate the portion(s) of the specification which dictate(s) the

structure relied on for proper interpretation and also to verify and ascertain the

metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
03JAN2008

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